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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/913,539

12/07/2001

Nigel P Taylor

9666

9629

7590

08/09/2002

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EXAMINER

FORD, JOHN M

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 08/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/913539

Applicant(s)

Koite and

Examiner

J.M. Ford

Group Art Unit

1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-10 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 1-3, and 7 is/are allowed.
- ☒ Claim(s) 4, 5 and 6, 8, 9 and 10 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☒ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).
- \*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) # 3
  - ☐ Interview Summary, PTO-413
  - ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

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Claims 4, 5 and 6 are rejected under 35 U.S.C. 112, 5th paragraph. A multiple dependent claim may not be dependent on a multiple dependent claim.

A new "Abstract" is requested. The USPTO now uses a photogravier process, *rather* than hand set the Abstract. The Abstract needs to be on one sheet of paper, by itself, with *no* other data on the page.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

BEM (formula I) is noted on pages 1 and 2 the specification. This seems to be claim 8. A new process does not make the compound allowable, again. Accordingly, claim 8 is rejected. Applicants seem to be saying BEM is known.

Note the PCT search found these processes did not include an inventive step.

"Due to the chemical structure of the educt and product the claimed process is considered to be novel vis-a-vis the state of the art as represented by the documents cited in the International Search Report (IPER). From these documents the Wittig-type olefination of DPPO of formula II is known to yield compounds very similar in structure to BEM of formula I of the present application.

It appears that the man skilled in the art when faced with the problem of preparing BEM who was aware of the olefination processes disclosed in the documents cited in the IPER would expect the process of the present application to exhibit the desired effects.

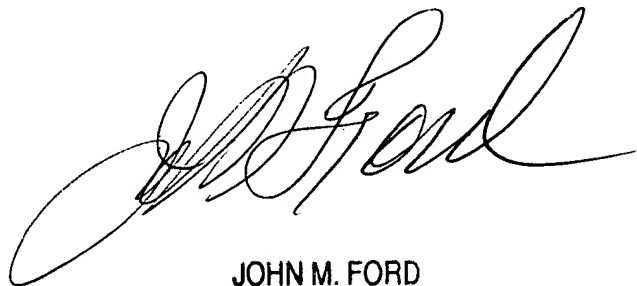
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Thus, the process claimed is considered to be an analogy process not exhibiting any nonobvious properties or effects and, consequently, not to involve an inventive step. The subject-matter claimed does therefore not fulfil the requirements of Art. 33 (3) PCT.”

Accordingly, claims 9 and 10 are rejected under 35 U.S.C. 103 in view of the Y designation of the art on the PCT search report.

John M. Ford:jmr

August 6, 2002

A handwritten signature in black ink, appearing to read 'J. M. Ford', with a large, sweeping flourish at the end.

JOHN M. FORD  
PRIMARY EXAMINER  
GROUP - ART UNIT 1624